

## REMARKS/ARGUMENTS

### **New claim**

New claim 67-69 are hereby introduced and no new matter is presented. Claim 67 relates to one embodiment where two s-shaped springs are used to urge a rotary member to rotate in a winding direction. Although the specification does not specifically mention the use of two springs to drive a rotary member, the applicant believes such limitation is still supported by the specification, since the specification does not mention any undesirability of using more than one spring. The use of two springs provides additional counterbalancing force than the one-spring design.

### **35 USC 103(a)**

The Office has previously presented Gertzson (2,594,637) and Kuhar (5,482,100) as the strongest basis for obviousness rejection under 35 U.S.C. § 103(a). The applicant respectfully disagrees. In view of the newly presented claims for continued prosecution, the applicant has the following comments:

#### **Lack of Motivation to Combine**

After it has been determined that certain prior art can be combined because it is analogous art, the Office must still show that the prior art contains a suggestion, i.e., a motivation, for the proposed combination. M.P.E.P. 2143.01. In other words, the prior art as a whole must contain something to suggest the "desirability," thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In addition, the court in *In re Johnston* (Fed. Cir. 2006) recently provided a review of its string of precedents concerning the standard for combining references in an obviousness rejection:

*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some

suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.");

*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) ("When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.");

*In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (there must be "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references");

*Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

Here, there is absolutely no teaching or suggestion to select and combine the Gertzson device with the Kuhar device. Gertzson discloses a manually operated window blind necessitating the use of pulleys and manual cord locking mechanism. Kuhar discloses a cordless blind using a single counterbalancing mechanism to directly keep the weight of the blinds in balance for various height positions. Kuhar made it clear that it intends on eliminating the conventional pull cords and locks of Venetian blinds in a simple and easily adaptable mechanism having few components parts (see col. 2, lines 3-8). Based on Kuhar's teaching, one of ordinary skill in the art would not have been motivated to create a much more complex cordless blind by creating a blind comprising the counterbalancing mechanism together with a pulley system (among other things). The applicant's general idea of having the counterbalancing mechanism cooperating with a pulley system is a revolutionary one, and certainly one that would not have been obvious to one of ordinary skill in the art.

The Kuhar patent offers no motivation to combine the two references. The Kuhar patent merely teaches one to replace the Gertzson device with the Kuhar device. In addition, combining the two references would not make the combined device more desirable for the intended purpose of keeping components simple as stated in Kuhar.

### **Motivation to Combine based on Impermissible Hindsight**

The applicant also respectfully adds that any motivation to combine the Gertzson patent and the Kuhar patent would constitute impermissible hindsight. The Office is using the same suggestion/motivation (having pulley to assist the counterbalancing force, using a two-line-feed-into-one-line configuration for storing onto a spool, using a single secondary line to prevent two lines from entangling, among others) that is disclosed in the current patent application.

"Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

### **The Kuhar Device would have been Destroyed in Such Combination**

In addition, due to the fundamental differences in the two mechanisms to raise blinds, combination of the two references would have destroyed the Kuhar device. As discussed earlier, Kuhar teaches using one or more spring-loaded spools to directly counterbalance the weight of the blinds and the bottom elongated member, in order to achieve the intended purpose of keeping the design simple with fewer component parts. The combination as suggested by the Office would at best result in a blind system having one or more spring-loaded spools directly pulling the cords without the aids of pulleys.

### **Teaching Away**

Furthermore, the Federal Circuit has indicated that one important indicium of nonobviousness is "teaching away from" the claimed invention by the prior art, and has reversed rejections of claims where it found that prior art references applied by the PTO in fact teaching

away from what was being claimed. Therefore, an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553).

Again, as discussed, the Kuhar patent teaches away from having a complicated system of utilizing a spring-loaded spool in combination with a pulley system, among other components. Kuhar simply requires the use of spring-loaded spool alone to counterbalance the weight of the blind slats and the weight of the bottom elongated member.

### **Office has the Burden of Proof**

The applicant respectfully notes that the Office has the initial burden of setting forth a prima facie case of obviousness, and to do that the Office must identify **specific** teachings, suggestions or motivations in the prior art for making the claimed combination. Merely pointing out that various elements by themselves are known in the prior art is insufficient. Nor is it sufficient to merely state that combination of the missing elements is obvious because their combination would be beneficial. If that were the standard nothing would ever be patentable.

### **Objective Evidence of Nonobviousness**

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

1. Commercial Success - The applicant company has grown from a relatively small company in Taiwan with no U.S. market share, to a large entity

corporation in recent years due to its innovation in blind coverings. Particularly, it was not until the launch of the cordless blind (as claimed) that the applicant enjoyed greatly expanded North America market share. In fact, the launch of the applicant's cordless blinds enticed and initiated business relationships with large retailers the applicant has never before dealt with. For example, when it was first introduced (January of 2004), the cordless blind as claimed was quickly picked up by J.C. Penny, a large North America retailer. J.C. Penny continues to sell cordless blinds as claimed to this day. **The cordless blind as claimed are also being sold by the applicant company to other major retailers such as Target®, Wal-mart®, Bed Bath and Beyond®, and Lowe's®.** The Kuhar device, on the other hand, has not reached such popularity, even though the Kuhar device was (and continue to be) offered by Newell Operating Company, the second largest window covering company in the world.

2. Long-felt need - There has been a long felt need to provide cordless blinds. Child strangulation caused by corded blinds has renewed interests in a cordless design for blinds. **Organizations such as the Window Covering Safety Council (WCSC), a coalition of major U.S. manufacturers, importers, and retailers of window coverings dedicated to educating consumer about window cord safety, continue raising public awareness in potential window-cord hazards facing young children. WCSC in particular provides consumers with free retrofit kits and information to minimize window-cord hazards. And according to statistics compiled and researched by Parents for Window Blind Safety™, over 768 children have died from corded window treatments since 1973. Nevertheless, there was no effective cordless blind design until the applicant cordless blind came on the market. This long-felt need has been satisfied by the claimed design and evidenced by applicant company's explosion in sales to major North American retailers which they were never able to do business with in the past. As mentioned earlier, the applicant currently provides the**

**claimed product to retailers such as Target®, Wal-mart®, Bed Bath and Beyond®, and Lowes®.**

3. Failure of others – Newell Operating Company, assignee of the Kuhar patent, has been offering the Kuhar system, but the Kuhar system is difficult to operate, because it requires a user to pull hard on the bottom member in order to lower the height of the bottom member. The Kuhar system was not widely available, and can be found only in the made-to-order blinds market, not in the consumer retail market.
4. Copying by others – There are currently at least two known companies (namely Wholespace and Ching Feng) that have been offering the same cordless blinds as claimed, to the consumer public through JCPenney®. The applicant has initiated law suit against Wholespace, Co. in Canada based on applicant's issued Canadian patent on the same subject matter. Wholespace, in particular, was initially the "middleman" for the applicant's sale of the cordless blinds to JCPenney®, started in January of 2004. After a mere six months, Wholespace (the middleman) copied the same cordless blind from the applicant and began selling them directly to JCPenney® without authorization from the applicant. As a result, the applicant has lost some of its North America market shares by unauthorized copies of the cordless blind system as claimed. Negotiation continues between the applicant and Wholespace regarding the dispute. It is clear, that Wholespace (the middleman) sees the lucrative market created by such innovative cordless design.

The applicant has, through the efforts of research and development, and from the feedback of its customers, invented a novel cordless blind. This cordless blind has brought many positive and surprised feedbacks from end users for its ease of use and of its cost-effectiveness. It has many advantages over the Kuhar device by providing the above mentioned unexpected advantages.

## **Overview of the Kuhar Device**

The embodiment disclosed in figure 2 of Kuhar has two or more cords wound around the same spring-loaded spool. Cords are prone to tangle up on the same spool, thereby causing the bottom member to become unlevelled over time.

Also, the single spool configuration of figure 2 requires a relatively large spool to store multiple cords. This is undesirable as it requires a large, unsightly, upper rail to hold the large spool and spring assembly.

In figure 6, since the Kuhar device desires simplicity in component parts, and its elimination of manual pull cords has obviated the need for a pulley system, the Kuhar device has no pulley system in place. The Kuhar device has the spring-loaded spool directly suspending the weight of the blind slats and bottom member. This “direct suspension” makes it difficult for the end user to pull on the bottom member. An end user usually needs to pull hard on the bottom member to lower the blinds. And because of this configuration, exact height of the bottom member is less precise and relatively harder to adjust. In other words, the bottom member is prone to bounce up and down, since it is directly suspended by the spring-loaded spool.

Please note that the Kuhar device is still currently on the market.

While the embodiment of figure 3 provides a multiple spools system, with only one cord for each spool, such configuration is costly to manufacture and thus undesirable.

**Request For Allowance**

Claims 50-69 are pending in this application. The applicant thanks Examiner Johnson for his dedication and helpful advice throughout the examination of this application. The applicant hereby respectfully requests allowance of all pending claims.

Respectfully submitted,  
WPAT, P.C.

By /Anthony S. King/  
Anthony S. King  
Registration No. 49,063  
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WPAT, P.C.  
2030 Main Street  
Suite 1300  
Irvine, CA 92614  
Telephone (949) 202-5592  
Fax (949) 202-5595